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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/521,176
Filing Date: March 08, 2000
Appellant(s): OZAWA, TOSHIRO

MAILED

JUN 12 2006

Technology Center 2600

Ozawa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 2, 2006 appealing from the Office action mailed October 19, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,721,829	DUNN et al	2-1998
2002/0041053	ABECASSIS	11-2001

5,914,712	SARTAIN et al	6-1999
6,477,647	VENKATRAMAN et al	11-2002
5,613,190	HYLTON	3-1997
5,550,863	YURT et al	8-1996
5,805,763	LAWLER et al	9-1998
5,706,452	IVANOV	1-1998

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claims 1, 3, 11, 13, 21, 23, 31, 32, 37, and 38, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al. (5,721,829) [Dunn] in view of Abecassis (US 2001/0041053), Sartain et al. (5,914,712) [Sartain], Venkatraman et al. (6,477,647) [Venkatraman] and Hylton (5,613,190).

Regarding claims 1, 11, 21, 31, and 37, Dunn discloses a program distribution system and method (fig. 1, col. 2, lines 40-44) comprising:

A receiver (fig. 1, STB 26); and

A transmitter (fig. 1, headend 20) including a distribution controller (fig. 1, media server 40);

Said receiver being operable to accept a user request for a desired program (col. 5, lines 24-31);

Said transmitter including a distributable program storing unit (fig. 1, program storage 42) operable to store a plurality of distributable programs (col. 3, lines 46-51), said distribution controller (40) being operable to receive the

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distribution request (STB message, col. 5, lines 29-34), read out the requested program from said distributable program storing unit and distribute said program from a distributor to said receiver (col. 5, lines 24-41).

Dunn fails to disclose the user request is in a free style text format and converting the user request into a distribution request e-mail message that includes the user request and that is addressed to said distribution controller of said transmitter, which is sent to the transmitter, wherein said transmitter receives the request e-mail message and determines whether the requested program is one of the stored plurality of programs, to transmit an answer e-mail message to said receiver in response to the distribution request e-mail message, the answer e-mail message including a notice of correspondence and including supplemental information when the requested program is one of the stored plurality of distributable programs, the supplemental information including cryptanalytic information for decrypting the program, and sending the program when the requested program is one of the stored plurality of distributable programs.

In an analogous art, Abecassis teaches a video on demand service (paragraph 179) wherein users access programs using requests that comprise keyword searching and retrieval (users type in search terms in a free form style, paragraph 315), which involves comparing a word within a distribution request with stored descriptions of programs and reading out the selected program if one

of the stored the descriptions corresponds to said word. A keyword search allows users to quickly find a desired distributable program.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, and transmitter of Dunn to include free style text user requests, where the system determines whether the requested program is one of the stored plurality of programs based on the users request, as taught by Abecassis. The reason for doing so is to allow users to quickly find a desired program without linearly incrementing their way through a list.

Dunn and Abecassis fail to disclose converting the user request into a distribution request e-mail message that includes the user request and is addressed to said distribution controller of said transmitter and to transmit an answer e-mail message to said receiver in response to the distribution request e-mail message, the answer e-mail message including a notice of correspondence and including supplemental information when the requested program is one of the stored plurality of distributable programs, the supplemental information including cryptanalytic information for decrypting the program.

In an analogous art, Sartain teaches a video on demand system (col. 2, lines 38-48) wherein distribution requests are made via e-mail (col. 10, lines 15-20) to the distribution controller of the system (the accounting service is provided through an email address, col. 10, lines 15-20, wherein the destination of said request [thus the address of the email request] is to the component that receives

requests [gateway 610], shown in fig. 5, col. 9 line 42 – col. 10 line 7), for the advantage of utilizing the internet for distribution requests.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, and transmitter disclosed by Dunn and Abecassis to include converting a distribution request into an e-mail addressed to the distribution controller of the transmitter, as disclosed by Sartain, for the advantage of utilizing the internet for distribution requests, a commonly utilized backchannel for television distribution systems.

Dunn, Abecassis, and Sartain fail to disclose transmitting an answer e-mail message to said receiver in response to the distribution request e-mail message, the answer e-mail message including a notice of correspondence and including supplemental information when the requested program is one of the stored plurality of distributable programs, the supplemental information including cryptanalytic information for decrypting the program.

In an analogous art, Venkatraman teaches the transmission of confirmation e-mails to users that includes correspondence information specifying the interaction, confirming the selections made by users when interacting with a remote computer system (col. 6, lines 8-57), providing users with the opportunity to confirm selections made to reduce the chance of unwanted selections and providing users with the chance to revoke a selection.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, and transmitter disclosed by Dunn, Abecassis,

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and Sartain to include confirmation e-mails that include a notice of correspondence in response to user selections, as taught by Venkatraman, for the benefit of reducing the chance of unwanted program title selections and providing users with the chance to revoke a program title selection.

Dunn, Abecassis, Sartain, and Venkatraman fail to disclose including cryptanalytic information for decrypting the program.

In an analogous art, Hylton teaches providing decryption keys to customer equipment in response to user requests for video services (col. 20 line 58 – col. 21 line 8), for the benefit of allowing users that have requested an encrypted video service to decrypt and subsequently watch said requested video.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, and transmitter disclosed by Dunn, Abecassis, Sartain, and Venkatraman to include cryptanalytic information for decrypting the program, as taught by Hylton, for the benefit of allowing users that have requested an encrypted video service to decrypt and subsequently watch said requested video.

Regarding claims 3, 13, 23, 32, and 38, Dunn, Abecassis, Sartain, Venkatraman, and Hylton disclose the system, method, and transmitter of claims 1, 11, 21, and 37, but fail to disclose said receiver is further operable to include a predetermined term in a subject filed in the distribution request e-mail message,

the predetermined term indicating that the distribution request e-mail message includes the user request.

The official notice taken that it is well known in the art to include in the subject line of e-mail messages a description of the body, contents, and/or purpose of the email message, allowing recipients of the email to readily identify the e-mail message, was not traversed by the applicant, and it thus taken as an admission of the fact therein.

Therefore, it would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, and transmitter of Dunn, Abecassis, Sartain, Venkatraman, and Hylton to include a predetermined subject filed in the distribution request e-mail message which indicates that the distribution request e-mail message includes the user request, for the benefit of allowing the recipient of the e-mail message to readily identify the e-mail message as a user request.

Claims 2, 6, 7, 8, 12, 16, 17, 18, 22, 26, 27, 28, 35, and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn, Abecassis Sartain, Venkatraman, and Hylton as applied to claims 1, 11, and 21 above, and further in view of Yurt et al. (5,550,863) [Yurt].

Regarding claims 2, 12, and 22, Dunn, Abecassis, Sartain, Venkatraman, and Hylton disclose the system, method, and transmitter of claims 1, 11, and 21, but fail to disclose the distributable program storing unit stores an associated title

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for each of the said plurality of distributable programs which is used for selecting a program.

In an analogous art, Yurt teaches a video on demand service (col. 2, lines 48-59) wherein item names are used to identify items (col. 10, lines 52-56), as item names are easier to remember, making user access to these items more intuitive.

It would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, and transmitter disclosed by Dunn, Abecassis, Sartain, Venkatraman, and Hylton to include the program's title, as taught by Yurt, wherein words in the user's request would then be compared to the titles associated with stored programs, for the advantage of making the search for a distributable program more intuitive and user friendly.

Regarding claims 6, 16, and 26, Dunn, Abecassis, Sartain, Venkatraman, Hylton, and Yurt disclose the system, method, and transmitter of claims 2, 12, and 22, wherein the answer e-mail message includes the notice of correspondence when the user request includes a title associated with one of the stored plurality of programs (as shown above regarding claims 1, 11, and 21, the notice of correspondence is included in the answer e-mail sent from the transmitter in response to a successful transaction request made by a user).

Regarding claims 7, 17, and 27, Dunn, Abecassis, Sartain, Venkatraman, and Hylton disclose the system, method, and transmitter of claims 1, 11, and 21, but fail to disclose said receiver is further operable to transmit a confirmation e-mail message to said distribution controller in response to the answer e-mail message when the answer e-mail message includes the notice of correspondence, the confirmation e-mail message indicating that the user of said receiver has agreed to purchase the requested program, said distribution controller reading out the requested program from said distributable program storing unit when said distribution controller receives the confirmation e-mail message.

In an analogous art, Yurt discloses user confirmation of a purchase (fig. 3, step 3100, col. 14, lines 6-12) in response to a system-generated confirmation prompt (col. 13 line 55 – col. 14 line 12) to fully insure that a user selection is correct (col. 14, lines 2-5).

It would have been obvious at the time to a person of ordinary skill in the art to further modify the system, method, and transmitter disclosed by Dunn, Abecassis, Sartain, Venkatraman, and Hylton to include transmitting a user confirmation of a user selection in response to a system-generated confirmation prompt, as taught by Yurt, wherein the confirmation would take the form of an e-mail response, as this is the established means by which the transmitter and receiver communicate, for the benefit of fully insuring that a user requested program title has been correctly selected.

Regarding claims 8, 18, and 28, Yurt additionally discloses user confirmation of a purchase (fig. 3, step 3100, col. 14, lines 6-12) in response to a system-generated confirmation prompt (col. 13 line 55 – col. 14 line 12) to fully insure that a user selection is correct (col. 14, lines 2-5).

It would have been obvious at the time to a person of ordinary skill in the art to further modify the system, method, and transmitter disclosed by Dunn, Abecassis, Sartain, Venkatraman, Hyton, and Yurt to include transmitting a user confirmation of a user selection in response to a system-generated confirmation prompt, as taught by Yurt, wherein the confirmation would take that form of an e-mail response, as this is the established means by which the transmitter and receiver communicate, for the benefit of fully insuring that a user requested program title has been correctly selected.

Regarding claims 35 and 40, Dunn, Abecassis, Sartain, Venkatraman, and Hylton disclose the receiver and method of claims 31 and 37, but fail to disclose said controller is further operable to transmit a confirmation e-mail message to the predetermined distribution unit when the answer e-mail message includes the notice of correspondence, the confirmation e-mail message indicating that the user of said receiver has agreed to purchase the requested program.

In an analogous art, Yurt teaches user confirmation of a purchase (fig. 3, step 3100, col. 14, lines 6-12) in response to a system-generated confirmation

prompt (col. 13 line 55 – col. 14 line 12) to fully insure that a user selection is correct (col. 14, lines 2-5).

It would have been obvious at the time to a person of ordinary skill in the art to further modify the receiver and method disclosed by Dunn, Abecassis, Sartain, Venkatraman, and Hylton to include transmitting a user confirmation of a user selection in response to a system-generated confirmation prompt, as taught by Yurt, wherein the confirmation would take that form of an e-mail response, as this is the established means by which the transmitter and receiver communicate, for the benefit of fully insuring that a user requested program title has been correctly selected.

Claims 9, 19, 29, 36, and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn, Abecassis, Sartain, Venkatraman, and Hylton as applied to claims, 1, 11, and 21 above, and further in view of Lawler et al. (5,805,763, of record) [Lawler].

Regarding claims 9, 19, and 29, Dunn, Abecassis, Sartain, Venkatraman, and Hylton disclose the system, method, and transmitter of claims 1, 11, and 21, but fail to disclose a recorder connected to said receiver, wherein said distribution controller is further operable to include in the supplemental information including a control command for causing said recorder to record the requested program.

In an analogous art, Lawler teaches a video on demand service (col. 4, lines 23-29) wherein the service automatically instructs a recorder (fig. 2, VCR 23, col. 5, lines 43-45) to record a selected program (col. 11, lines 7-13) by transmitting a control command (record tag, col. 12, lines 58-61) to a receiver (fig. 2, interactive station control 18, col. 13 lines, 7-18) to cause said recorder connected said receiver [18] (col. 5, lines 38-45) to record said selected program (col. 13, lines 20-25) by attaching said control command to a notice of correspondence (col. 13, lines 15-18), allowing a user to quickly and easily record a selected program for later use (col. 13, lines 38-43).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, and transmitter disclosed by Dunn, Abecassis, Sartain, Venkatraman, and Hylton to include transmitting to said receiver supplemental information including a control command to cause a recorder connected to said receiver to record said selected program by attaching said control command to a notice of correspondence [the answer e-mail message], as taught by Lawler, for the advantage of allowing a user to quickly and easily record a selected video on demand program for later use, as the user is relieved from having to manually set the recording parameters.

Regarding claims 36 and 41, Dunn, Abecassis, Sartain, Venkatraman, and Hylton disclose the receiver and method of claims 31 and 37, but fail to disclose an answer e-mail message received by said controller includes supplemental

information, the supplemental information including a control command for causing a recorder connected to said receiver to record the requested program.

In an analogous art, Lawler teaches a video on demand service (col. 4, lines 23-29) wherein the service automatically instructs a recorder (fig. 2, VCR 23, col. 5, lines 43-45) to record a selected program (col. 11, lines 7-13) by transmitting a control command (record tag, col. 12, lines 58-61) to a receiver (fig. 2, interactive station control 18, col. 13 lines, 7-18) to cause said recorder connected said receiver [18] (col. 5, lines 38-45) to record said selected program (col. 13, lines 20-25) by attaching said control command to a notice of correspondence (col. 13, lines 15-18), allowing a user to quickly and easily record a selected program for later use (col. 13, lines 38-43).

It would have been obvious at the time to a person of ordinary skill in the art to modify the receiver and method disclosed by Dunn, Abecassis, Sartain, Venkatraman, and Hylton to include transmitting to said receiver supplemental information including a control command to cause a recorder connected to said receiver to record said selected program by attaching said control command to a notice of correspondence [the answer e-mail message], as taught by Lawler, for the advantage of allowing a user to quickly and easily record a selected video on demand program for later use, as the user is relieved from having to manually set the recording parameters.

Claims 10, 20, 30, 43, 45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn, Abecassis, Sartain, Venkatraman, Hylton, and Yurt as applied to claims 6, 16, and 26 above, and further in view of Lawler.

Regarding claims 10, 20, and 30, Dunn, Abecassis, Sartain, Venkatraman, Hylton, and Yurt disclose the system, method, and transmitter of claims 6, 16, and 26, but fail to disclose a recorder connected to said receiver, wherein said distribution controller is further operable to include in the supplemental information including a control command for causing said recorder to record the requested program.

In an analogous art, Lawler teaches a video on demand service (col. 4, lines 23-29) wherein the service automatically instructs a recorder (fig. 2, VCR 23, col. 5, lines 43-45) to record a selected program (col. 11, lines 7-13) by transmitting a control command (record tag, col. 12, lines 58-61) to a receiver (fig. 2, interactive station control 18, col. 13 lines, 7-18) to cause said recorder connected said receiver [18] (col. 5, lines 38-45) to record said selected program (col. 13, lines 20-25) by attaching said control command to a notice of correspondence (col. 13, lines 15-18), allowing a user to quickly and easily record a selected program for later use (col. 13, lines 38-43).

It would have been obvious at the time to a person of ordinary skill in the art to modify the system, method, and transmitter disclosed by Dunn, Abecassis, Sartain, Venkatraman, Hylton, and Yurt to include transmitting to said receiver supplemental information including a control command to cause a recorder

connected to said receiver to record said selected program by attaching said control command to a notice of correspondence [the answer e-mail message], as taught by Lawler, for the advantage of allowing a user to quickly and easily record a selected video on demand program for later use, as the user is relieved from having to manually set the recording parameters.

Regarding claims 43, 45, and 47, Yurt additionally discloses supplemental information included in a system-generated confirmation of a user selection includes accounting information for the program (the amount of money the user must pay to purchase the program, col. 13 line 55 – col. 14 line 12), further allowing a user to determine if the price of the program is acceptable.

It would have been obvious at the time to a person of ordinary skill in the art to further modify the system, method, and transmitter disclosed by Dunn, Abecassis, Sartain, Venkatraman, Hylton, Yurt, and Lawler to include in the supplemental information the time and price of the program, and taught by Yurt, for the benefit of allowing a user to determine if the price of the program is acceptable to the user.

Claims 42, 44, 46, 48, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn, Abecassis, Sartain, Venkatraman, Hylton, and Lawler as applied to claims 9, 19, 29, 36, and 41 above, and further in view of Yurt.

Regarding claims 42, 44, and 46, Dunn, Abecassis, Sartain, Venkatraman, Hylton, and Lawler disclose the system, method, and transmitter of claims 9, 19, and 29, but fail to disclose the supplemental information includes accounting information for the program.

In an analogous art, Yurt discloses supplemental information included in a system-generated confirmation of a user selection includes accounting information for the program (the amount of money the user must pay to purchase the program, col. 13 line 55 – col. 14 line 12), further allowing a user to determine if the price of the program is acceptable.

It would have been obvious at the time to a person of ordinary skill in the art to further modify the system, method, and transmitter disclosed by Dunn, Abecassis, Sartain, Venkatraman, Hylton, and Lawler to include in the supplemental information the time and price of the program, and taught by Yurt, for the benefit of allowing a user to determine if the price of the program is acceptable to the user.

Regarding claims 48 and 49, Dunn, Abecassis, Sartain, Venkatraman, Hylton, and Lawler disclose the receiver and method of claims 36 and 41, but fail to disclose the supplemental information includes information consisting of the time of the program and the price of the program.

In an analogous art, Yurt teaches supplemental information included in a system-generated confirmation of a user selection includes accounting

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information for the program (col. 13 line 55 – col. 14 line 12), further allowing a user to determine if the price is acceptable.

It would have been obvious at the time to a person of ordinary skill in the art to further modify the receiver and method disclosed by Dunn, Abecassis, Sartain, and Lawler to include in the supplemental information accounting information for the program, and taught by Yurt, for the benefit of allowing a user to determine if the price is acceptable to the user.

(10) Response to Argument

A. Claims 1, 3, 11, 13, 21, 23, 31, 32, 37, and 38

Primarily, appellant's arguments focus on whether the Dunn reference, when modified in view of Sartain, teaches the claimed limitation of addressing an e-mail request to a distribution controller of a transmitter. The Dunn reference teaches a video on demand system (fig. 1) wherein orders for video content are received from a household at a headend (fig. 1, headend 20, see col. 5, lines 25-41). The Sartain reference teaches receiving orders for videos in a video on demand system in the form of an e-mail message (col. 10, lines 15-26). When Dunn is modified in view of Sartain, those messages which are sent to (addressed to) the headend, are converted into e-mail messages which are addressed to the distribution controller (that which controls the distribution of videos) of the headend.

First, appellant argues that a *prima facie* case of obviousness has not been met by arguing that not all claim limitations have been met, particularly the limitation of “to convert the user request into a distribution request e-mail message that includes the user request and that is addressed to said distribution controller of said transmitter” (claim 1, lines 6-9). Appellant supports this position by first stating that Sartain discloses addressing e-mail requests to an accounting service rather than the office that sends the selected programs to the subscriber’s television (appeal brief, page 7, lines 30-37), then stating that the external request gateway to which the e-mail is addressed does not provide video programming (appeal brief, page 8, lines 3-4), and further stating that by addressing the e-mail request to the external request gateway, the message is not addressed to a distribution controller of a transmitter (appeal brief, page 8, lines 27-30). Each of these arguments is an attempt to show how the teachings of Sartain cannot be relied upon to teach the claimed limitation of addressing an e-mail request message to the distribution controller of a transmitter (appeal brief, page 9, lines 7-9).

In response, it is necessary at this point to present a clear picture of the elements being claimed. Specifically, line 3 of claim 1 claims “a transmitter including a distribution controller”, this limitation being supported by the appellant’s disclosure as shown in fig. 1, elements 10 and 15 and pages 5-6 of the specification. The claimed distribution controller is VOD controller 15, shown in fig. 1 as an independent element connected to the Internet for receiving

requests and sending control information to separate video server 12. The claimed transmitter is identified as transmitter 10, which is comprised of a range of separate devices, including VOD controller 15, video server 12, encoders 11A..N, multiplexer 13, and modulator 14, all identified collectively as transmitter 10 by drawing a dashed box around the devices. From this description, the scope of the claimed term "distribution controller" is some device that receives requests and uses this information to control another device that outputs the requested video, and the scope of the term "transmitter" covers a range of separate devices which, when viewed collectively, receive requests for videos and output the videos.

Bearing in mind the actual scope and meaning of the terms "distribution controller" and "transmitter" as described above, there are discrepancies between the factual assumptions upon which appellant relies when addressing the Sartain reference and the subject matter actually being claimed. When appellant states that Sartain discloses addressing e-mail requests to an accounting service rather than the office that sends the selected programs to the subscriber's television, one could very well argue that appellant's own disclosure teaches addressing distribution requests to VOD controller 15 which processes user requests rather than video server 12 which actually (in conjunction with multiplexer 14 and modulator 14) send the selected programs to the subscriber's television. When appellant states that the external request gateway to which the e-mail is addressed does not provide video programming, one must recognize

that VOD controller 15 to which request e-mails are addressed does not provide video programming, video server 12 does. When appellant states that by addressing the e-mail request to the external request gateway, the message is not addressed to a distribution controller of a transmitter, one must recognize that, according to appellant's own specification, the external request gateway, which receives requests and forwards data to another device which output requested video programs according to said data, is equivalent to the claimed distribution controller. All arguments made by the examiner in previous actions in relation to the applicability of the Sartain reference have been made according this line of reasoning, and thus do not require any further elaboration here.

Second, appellant states that the burden is on the examiner and not the appellant to show that the Sartain reference discloses a distribution request e-mail message that includes the user request and that is addressed to a distribution controller of a transmitter (appeal brief, page 8 line 31 through page 9 line 6) in response to the examiner pointing out that details not found in the Sartain reference would be required to validate appellant's arguments against the Sartain reference (namely, that the accounting service is necessarily a separately managed entity).

In response, this is not an issue of who carries the burden for establishing a *prima facie* case of obviousness, but rather a reinforcement of the original case made by the examiner regarding the combination of Dunn and Sartain relating to

the claimed invention. Originally, appellant argued that while Dunn sent orders directly to a headend, Sartain addressed orders to an accounting service, arguing under the assumption that an accounting service could in no way be considered a part of the headend disclosed by Dunn as there was no suggestion to modify Dunn in such a manner (see appellant's remarks, page 15, submitted August 11, 2005). One of the examiner's responses to this argument was that it was flawed because it required a practitioner of ordinary skill in the art to assume the accounting service could not be considered in any way to be a part of a headend, which would require details about the accounting service that are not disclosed in the Sartain reference (see page 2 of the office action mailed October 19, 2005). Another of the examiner's responses was to show how one of ordinary skill in the art would be motivated to combine Dunn and Sartain in a manner such that the accounting service is considered a part of the headend as a whole (see Advisory action mailed February 3, 2006). Lastly, the examiner pointed out that additionally, the combination of Dunn and Sartain results in a system that strictly meets the claimed limitations (see Advisory action mailed February 3, 2006). Also, the burden of the examiner has been to show how the combination of the Dunn and Sartain references, considered together as a whole, teach the claimed invention, as a whole, and not how any one reference teaches a particular claimed limitation.

Third, appellant argues the Dunn does not disclose the headend performing tracking and billing functions (appeal brief, page 9 line 10 through page 11 line 5), said argument in response to a statement made by the examiner on page 2 of the office action mailed October 19, 2005.

In response, the examiner did not refer to Dunn alone, but to Dunn and Sartain in combination. An elaboration of how this combination would meet the claimed limitations with respect to the examiner's assertion was made in the Advisory action mailed on February 3, 2006. Further, whether or not Dunn discloses performing tracking and billing functions is not relevant to the claimed invention.

Fourth, appellant argues that Dunn neither discloses nor suggests sending an e-mail message (appeal brief, lines 18-22) and Sartain addresses the e-mail message to an accounting service (appeal brief, lines 23-30), and therefore cannot teach the claimed limitations of converting a user request into a distribution request e-mail message that is addressed to a distribution controller (appeal brief, page 12, lines 4-10).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). This sort of piecemeal analysis has already been

addressed in the Advisory action mailed on February 3, 2006 which described how the combination of Dunn and Sartain meet the claimed limitation in question.

Fifth, appellant argues that there is no motivation to combine the Dunn and Sartain references, citing that Dunn does not teach sending an e-mail message and thus does not provide motivation for modifying Sartain to send an e-mail message to the headend, and citing that Sartain describes addressing an e-mail message to an accounting service, therefore providing no motivation to modify Dunn to send an e-mail message to the headend (appeal brief, page 12 line 22 through page 13 line 4).

In response, the motivation for modifying Dunn in view of Sartain is, as stated, for the benefit of utilizing the Internet for making video on demand requests. Arguing that Sartain may not send the e-mail directly to a distribution controller but addressing it to a separate entity first, does not negate the cited motivation for utilizing e-mail to make the requests.

Sixth, appellant argues that the examiner's argument that Dunn sends orders directly to a headend is not pertinent to the claimed limitation of addressing an e-mail request to the distribution controller because the order disclosed by Dunn is not an e-mail (appeal brief, page 13, lines 5-16).

In response, this argument is considered pertinent because it is the combination of Dunn and Sartain, considered as a whole, which must be

considered. The Dunn reference sends a request for a video directly from the customer's household to the video distribution headend. Arguing that the Sartain reference may take a less direct route by addressing messages to an intermediary for no given reason is to ignore the context established by the primary reference, which is that of sending orders for videos directly from the home to the headend.

Seventh, appellant argues that Venkatraman does not disclose or suggest transmitting an answer e-mail message in response to a distribution request e-mail message because Venkatraman discloses confirmation e-mails in response to on-line trades (appeal brief, page 13, lines 22-34).

In response, the Venkatraman reference teaches sending confirmation e-mail messages in response to electronic transactions. The Dunn and Sartain references also deal with making electronic transactions (e-mail requests for videos), and while the nature of the transactions in question (on-line trading versus video program requests) may be different, the problem to be solved in both instances is the same, that of receiving confirmation of said transaction. Venkatraman provides a solution in the form of confirmation e-mails sent to users in response to an electronic transaction, and is relied upon for such.

Eighth, appellant argues that the Venkatraman reference is non-analogous art, as Venkatraman is concerned with confirming trade transactions and not with program distribution (appeal brief, page 14, lines 6-14).

In response, as described above, Venkatraman qualifies as analogous art in the following manner. The combination of Dunn and Sartain describes a system wherein electronic transactions are carried out over an Internet medium (e-mail), but with no means for confirming these transactions. Venkatraman also describes a system wherein electronic transactions are carried out over an Internet medium (web page), and also provides a means for confirming these transactions (confirmation e-mail).

B. Claims 2, 6-8, 12, 16-18, 22, 26-28, 35, and 40

Appellant simply states that Yurt does not remedy the deficiencies of the references as applied to the independent claims.

C. Claims 9, 19, 29, 36, and 41

Appellant simply states that Lawler does not remedy the deficiencies of the references as applied to the independent claims.

D. Claims 10, 20, 30, 43, 45, and 47

Appellant simply states that claims 10, 20, 30, 43, 45, and 47 are allowable for the reasons described above regarding claims 1, 11, and 21.

E. Claims 42, 44, 46, 48, and 49

Appellant simply states that claims 42, 44, 46, 48, and 49 are allowable for the reasons described above regarding claims 1, 11, 21, 31, and 37.

Lastly, regarding claims 3, 13, 23, 32, and 38, the examiner had taken official notice that it was notoriously well known at the time to include in the subject line a description of the body, content, and/or purpose of the email message, allowing recipients of the e-mail to readily identify the e-mail message. While this taking of official notice was not traversed by the appellant, examiner submits US Patent No. 5,706,452 to Ivanov, which supports the examiner's position regarding said facts (see col. 17 lines 50 – col. 18 line 3).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Dominic Saltarelli

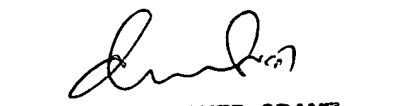
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